

**UNITED STATES  
PATENT AND TRADEMARK OFFICE**





# Patent Public Advisory Committee Quarterly Meeting Patent Trial and Appeal Board Update

**Scott R. Boalick, Acting Chief Administrative Patent Judge**

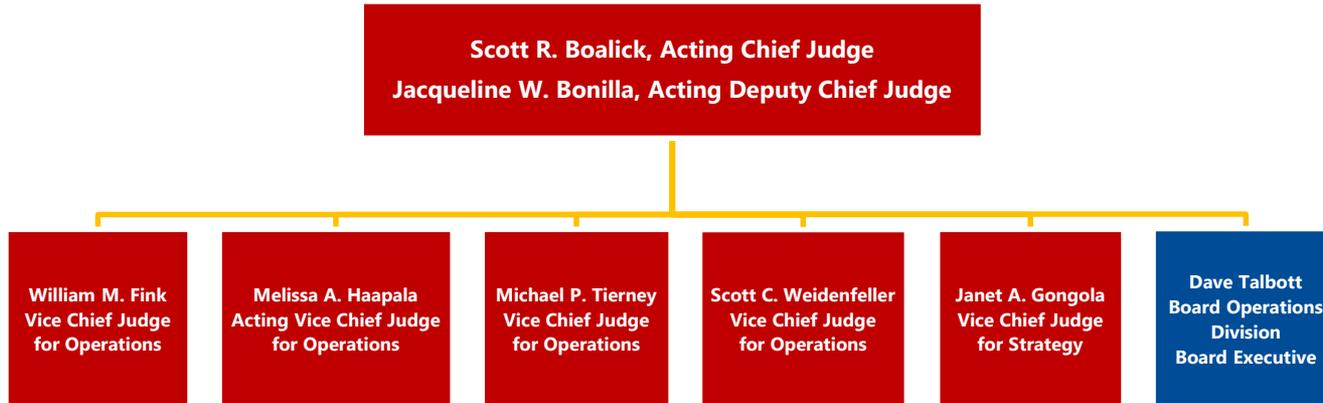
**Jacqueline Wright Bonilla, Acting Deputy Chief Administrative Patent Judge**

**February 7, 2019**

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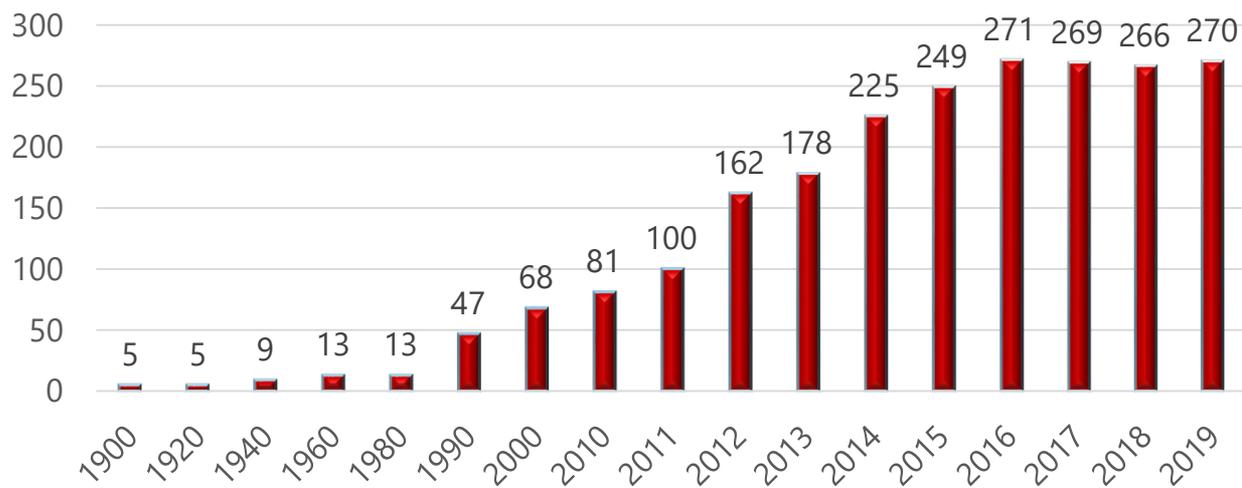


# Patent Trial and Appeal Board Organizational Structure



# Board size over time

(Calendar year)



# Locations of PTAB Judges



\*Alexandria, Va. count includes judges who participate in TEAPP.

\*\* The number in parenthesis next to each location indicates the number of judges in that location.

# AGENDA

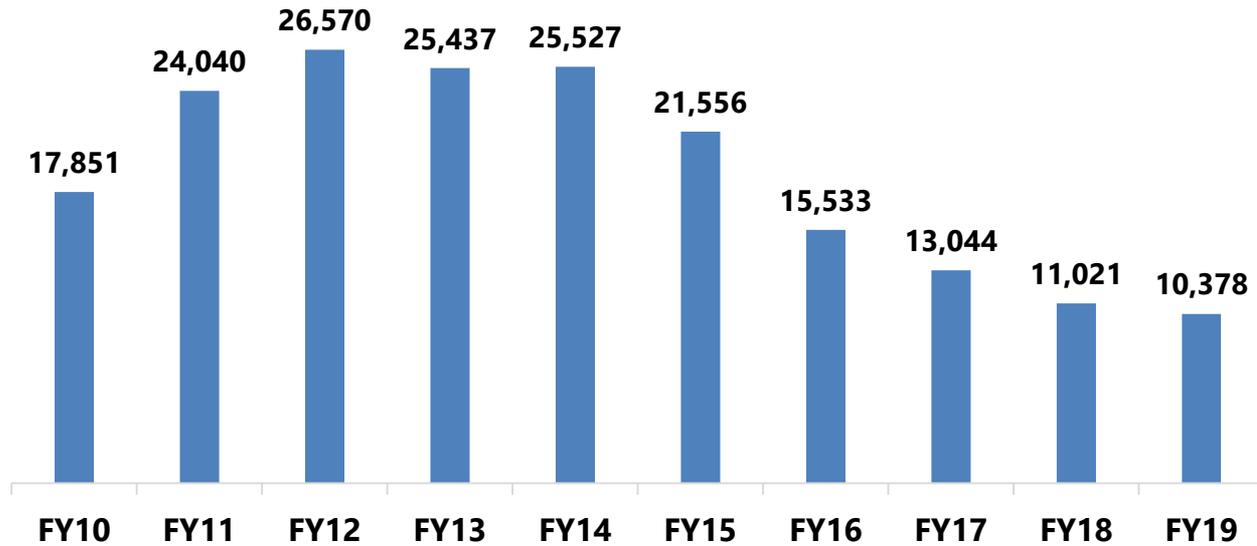
- **PTAB statistics**
  - Appeal and interference statistics (December 2018)
  - Trial statistics (December 2018)
- **PTAB updates**
  - Precedential Opinion Panel
  - Motion to amend practice

# PTAB STATISTICS

- Appeal and interference statistics (December 2018)
- Trial statistics (December 2018)

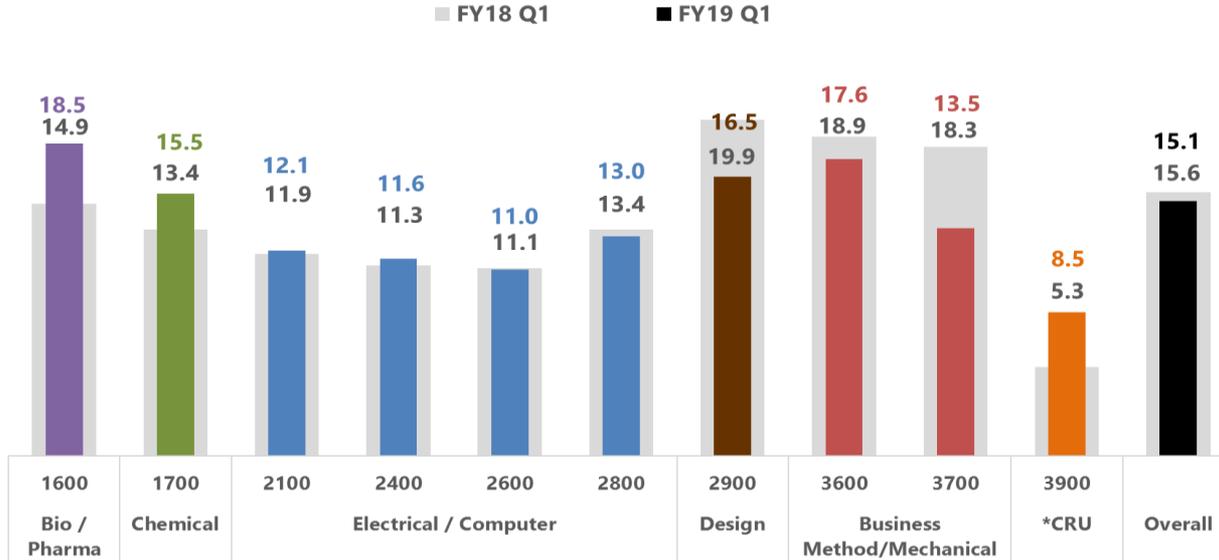
# Pending appeals

(FY10 to FY19: Sept. 30, 2010 to Dec. 31, 2018)



# Pendency of decided appeals in FY18 and FY19

(Pendency of appeals decided in FY18 Q1 compared to FY19 Q1 in months)

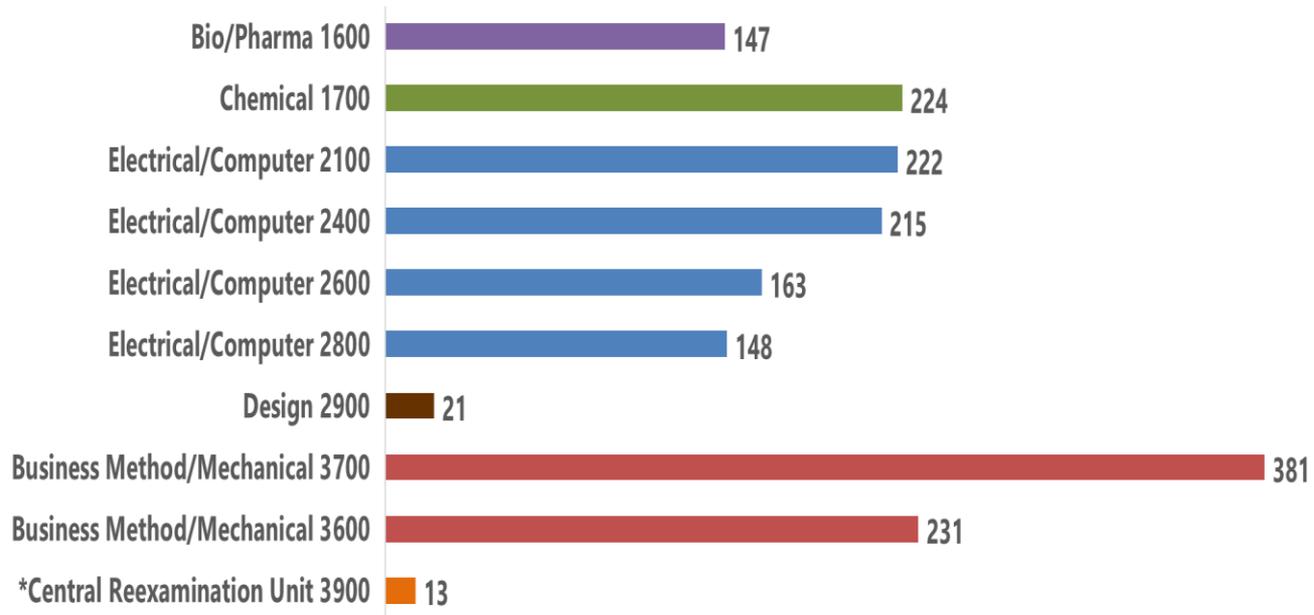


Pendency is calculated as average months from Board receipt date to final decision.

\*CRU (Central Reexamination Unit) includes ex parte reexams, inter partes reexams, supplemental examination reviews and reissues from all technologies.

# Appeal intake in FY19

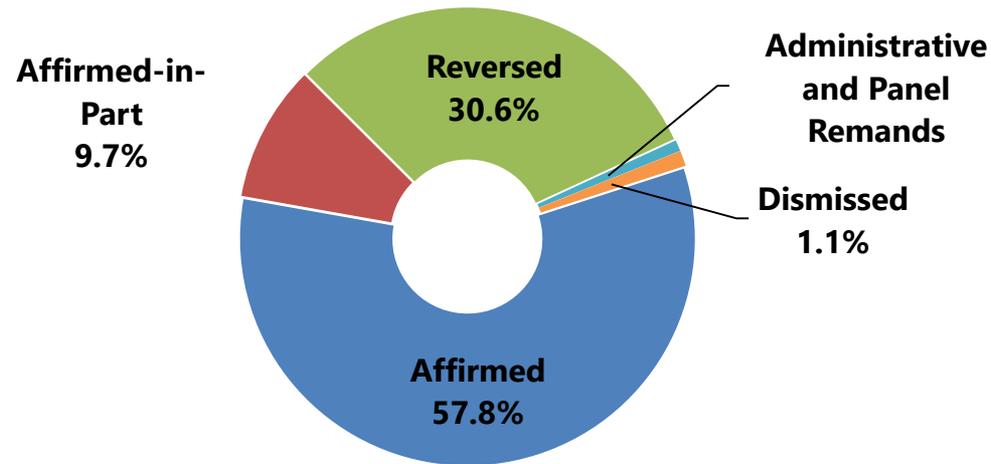
(Oct. 1, 2018 to Dec. 31, 2018)



\*The Central Reexamination Unit includes ex parte reexams, inter partes reexams, supplemental examination reviews and reissues from all technologies.

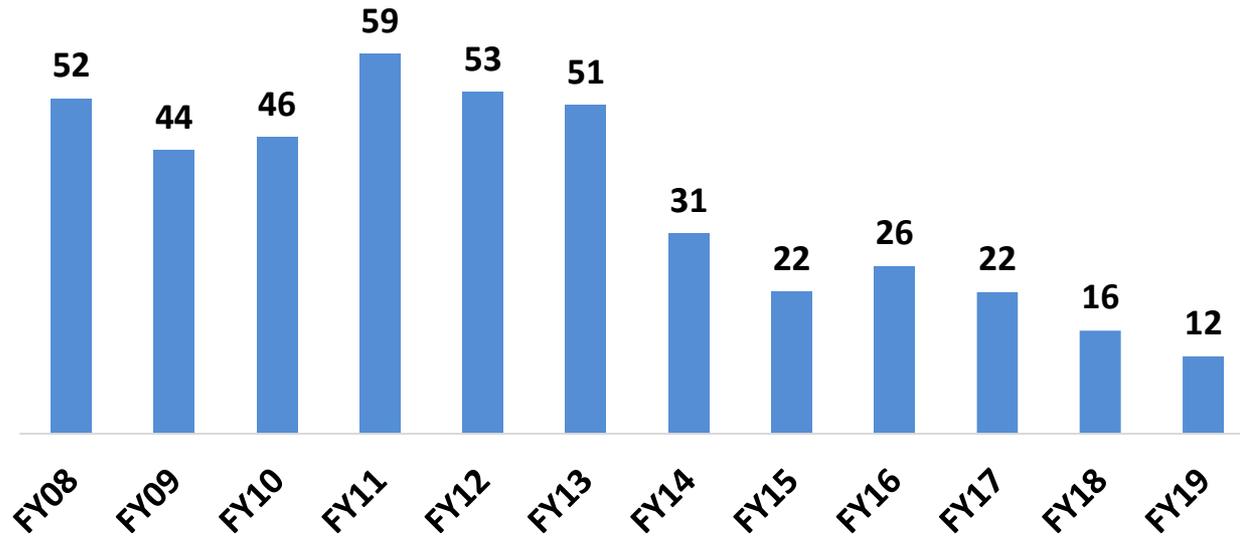
# Appeal outcomes in FY19

(Oct. 1, 2018 to Dec. 31, 2018)



# Interference inventory

(FY08 to FY19: Sept. 30, 2008 to Dec. 31, 2018)

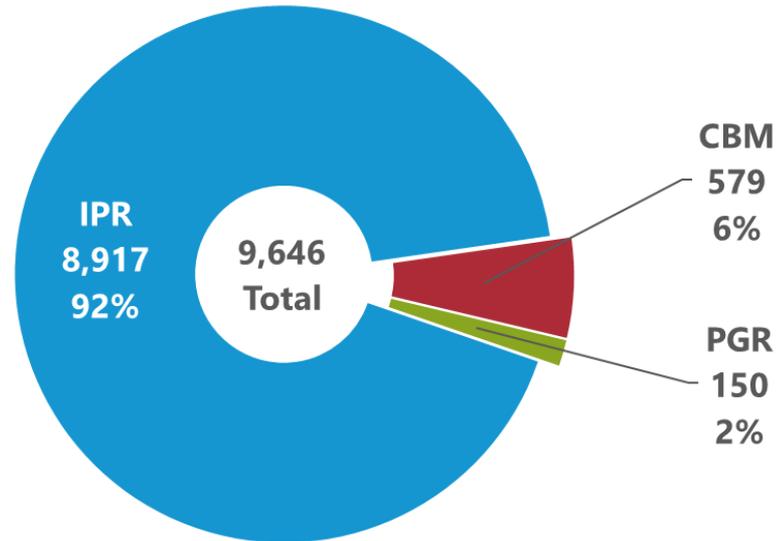


# PTAB STATISTICS

- Appeal and interference statistics (December 2018)
- Trial statistics (December 2018)

# Petitions by trial type

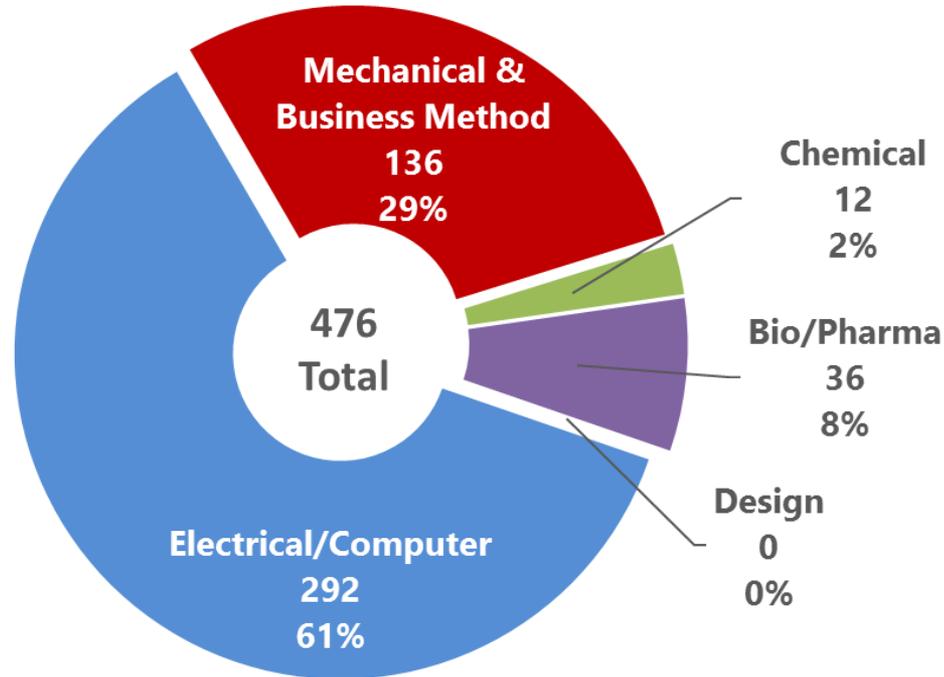
(All time: Sept. 16, 2012 to Dec. 31, 2018)



Trial types include Inter Partes Review (IPR), Post Grant Review (PGR), and Covered Business Method (CBM).

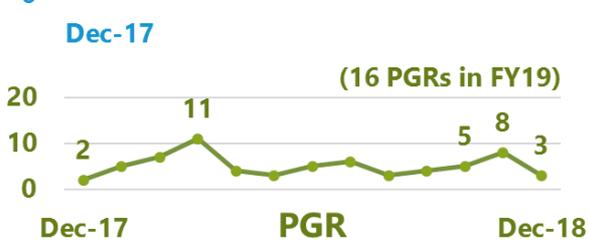
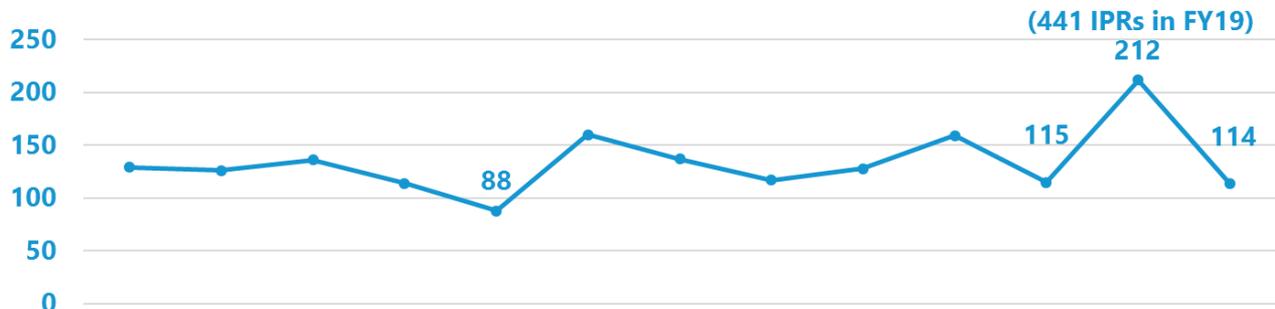
# Petitions filed by technology in FY19

(FY19: Oct. 1, 2018 to Dec. 31, 2018)



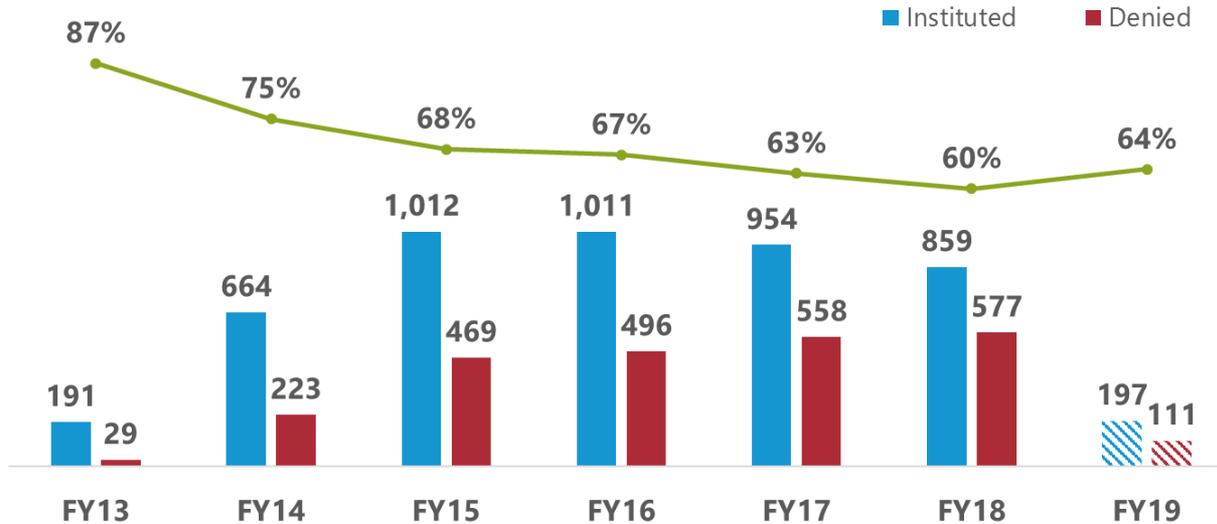
# Petitions filed by month

(December 2018 and previous 12 Months: Dec. 1, 2017 to Dec. 31, 2018)



# Institution rates

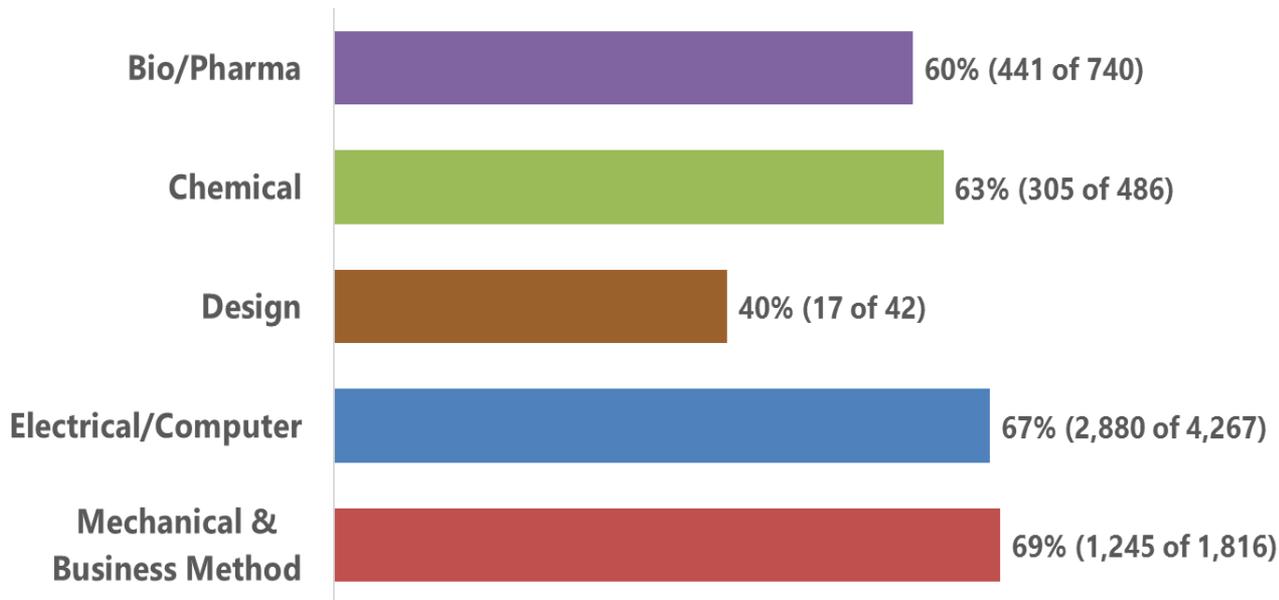
(FY13 to FY19: Oct. 1, 2012 to Dec. 31, 2018)



Institution rate for each fiscal year is calculated by dividing petitions instituted by decisions on institution (i.e., petitions instituted plus petitions denied). The outcomes of decisions on institution responsive to requests for rehearing are excluded.

# Institution rates by technology

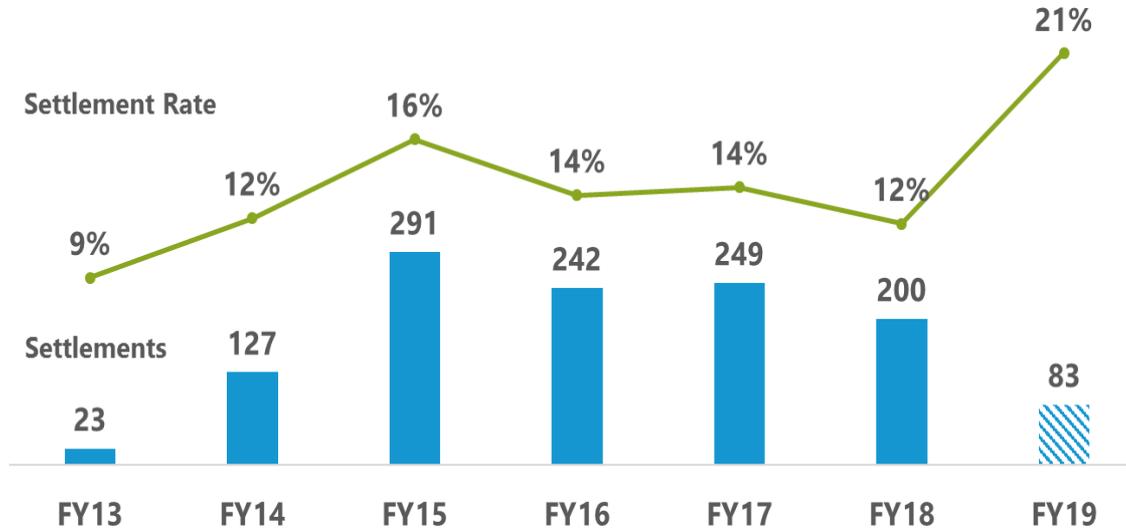
(All time: Sept. 16, 2012 to Dec. 31, 2018)



Institution rate for each technology is calculated by dividing petitions instituted by decisions on institution (i.e., petitions instituted plus petitions denied). The outcomes of decisions on institution responsive to requests for rehearing are excluded.

# Pre-institution settlements

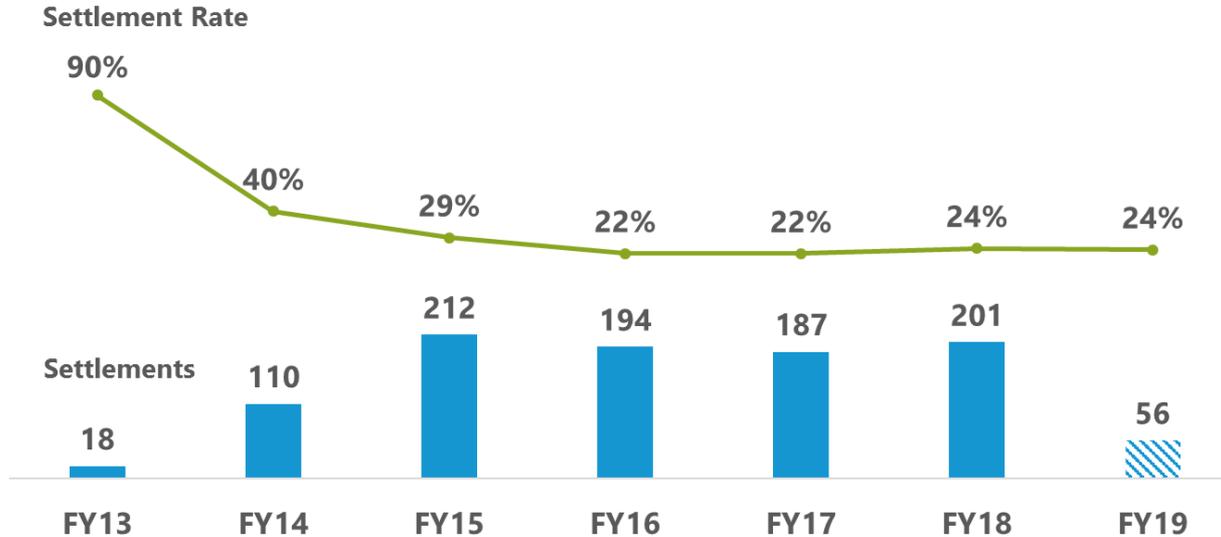
(FY13 to FY19: Oct. 1, 2012 to Dec. 31, 2018)



Settlement rate for each year is calculated by dividing pre-institution settlements by the sum of proceedings instituted, denied institution, dismissed, terminated with a request for adverse judgment, and settled before decision on institution.

# Post-institution settlements

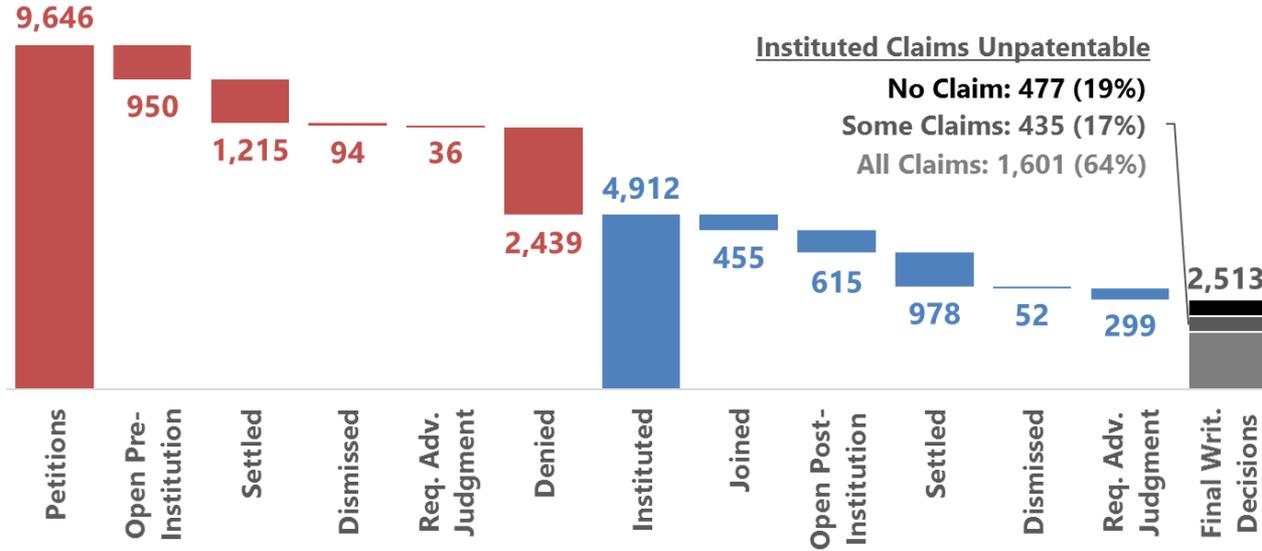
(FY13 to FY19: Oct. 1, 2012 to Dec. 31, 2018)



Settlement rate for each year is calculated by dividing post-institution settlements by proceedings terminated post-institution (i.e., settled, dismissed, terminated with a request for adverse judgment, and final written decision), excluding joined cases.

# Status of petitions

(All time: Sept. 16, 2012 to Dec. 31, 2018)



These figures reflect the latest status of each petition. The outcomes of decisions on institution responsive to requests for rehearing are incorporated. Once joined to a base case, a petition remains in the Joined category regardless of subsequent outcomes.

# PTAB UPDATES

- Precedential Opinion Panel
- Motion to amend practice

# Standard Operating Procedure 2

## September 2018 update

- Provides new Precedential Opinion Panel (POP) for creating binding Board precedent on rehearing
- Provides notice to the parties when POP review takes place, as well as the identification of the POP members in a particular case
- Explains the standards, procedures, and timing for requesting POP review in a pending case on rehearing
- Provides for designation and de-designation of precedential opinions by the Director

# Precedential Opinion Panel

- Outlined in PTAB SOP2, available at <https://www.uspto.gov/sites/default/files/documents/SOP2%20R10%20FINAL.pdf>
- Criteria:
  - Constitutional questions
  - Important questions regarding statutes, rules, regulations
  - Important issues regarding precedential case law
  - Issues of broad applicability to Board
  - Resolve conflicts between Board decisions
  - Promote certainty and consistency
- Default composition
  - Director
  - Commissioner for Patents
  - PTAB Chief Judge

# Standard Operating Procedure 2

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The Patent Trial and Appeal Board (PTAB) conducts trials, including inter partes, post-grant, and covered business method patent reviews and derivation proceedings; hears appeals from adverse examiner decisions in patent applications and reexamination proceedings; and renders decisions in interferences.

- Trials**  
Manage or review pending inter partes review, post-grant review, covered business method, derivation, and interference proceedings.
- Appeals**  
Manage or review proceedings directed to adverse decisions of examiners in patent applications, reissue applications, and reexaminations of issued patents.
- Decisions**  
Browse public final agency decisions of PTAB, including decisions designated as precedential or informative.
- Hearings**  
Review guidance, schedules, and incumbent weather advisories for oral arguments for appeals, interferences, and trials.
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**SOP 2 (rev. 10): Precedential opinion panel to decide issues of exceptional importance involving policy or procedure**

**SOP2 URL:**

<https://www.uspto.gov/sites/default/files/documents/SOP2%20R10%20FINAL.pdf>

# Standard Operating Procedure 2

The screenshot shows the USPTO website's Patent Trial and Appeal Board section. The navigation menu on the left includes links for Trials, Appeals, Decisions, Resources and guidance (highlighted with a red box), Statistics, Hearings, PTAB Data Tools and IT Systems, and PTAB Events. The main content area features several informational cards, including 'Request for Comments on Motion to Amend Practice-Deadline extended', 'Comments on Motion to Amend Practice and Procedures in AIA Trials', 'Claim Construction Final Rule', 'SOP 1 (rev. 15): Assignment of judges to panels', and 'SOP 2 (rev. 10): Precedential opinion panel to decide issues of exceptional importance involving policy or procedure'.

## Resources and guidance



Policies, procedures, rules, guides, tools and manuals associated with proceedings before the Patent Trial and Appeal Boards.

Expand all | Collapse all

- > Appeals
- > Trials
- > Reexams and interferences
- > Standard operating procedures
  - [SOP 1 \(rev. 15\): Assignment of judges to panels](#) (20 Sept 2018)
  - [SOP 2 \(rev. 10\): Precedential opinion panel to decide issues of exceptional importance involving policy or procedure](#) (20 Sept 2018)
  - [SOP 9 \(rev. 1\): Procedure for Decisions Remanded from the Federal Circuit](#)
- > Guidance
- > Statutes, rules, and references
- > Rulemaking
- > FAQs

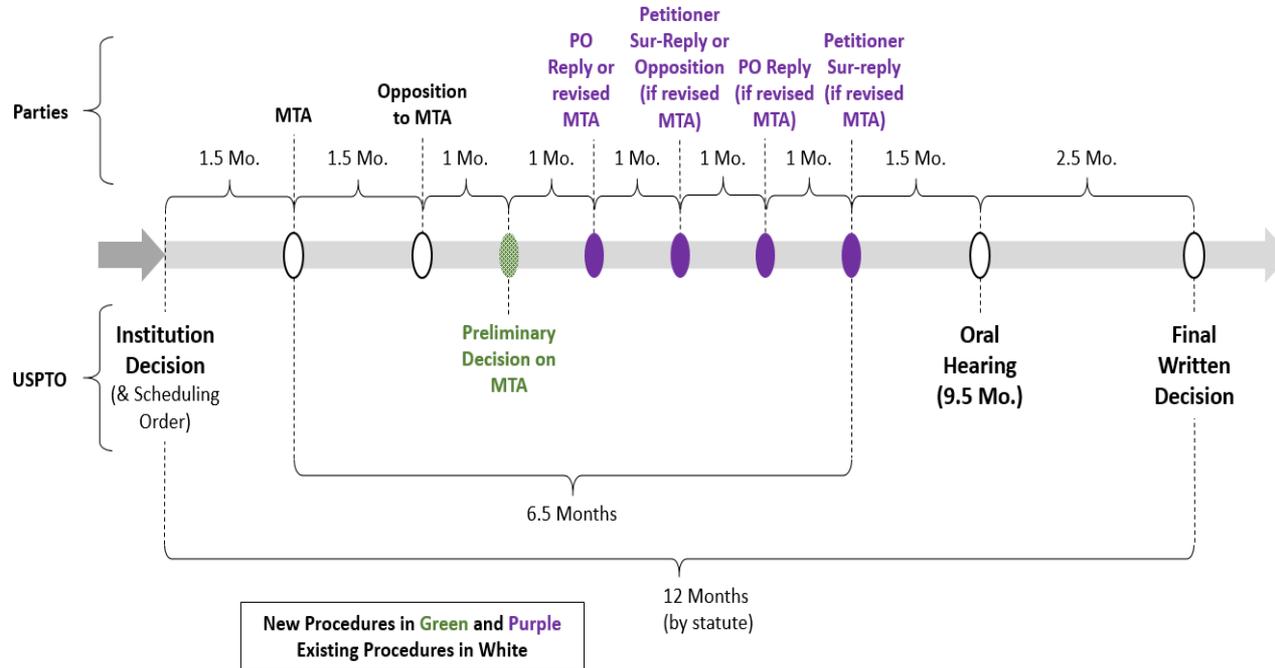
# PTAB UPDATES

- Precedential Opinion Panel
- Motion to amend practice

# Request for comment on proposed changes to motion to amend (MTA) practice in AIA trials

- Published on October 29, 2018
- Sought input regarding:
  1. New process involving a preliminary non-binding Board decision addressing a MTA, and an opportunity for a patent owner to revise its MTA thereafter
  2. Burden of persuasion regarding the patentability of substitute claims, as set forth in *Western Digital* order
- Included 17 questions of particular interest
- Comment period closed December 21, 2018

# Proposed timeline for proposed motion to amend process



# Request for comment on MTA practice

- 49 stakeholders provided comments (as of December 21, 2018):
  - 11 from companies (covering a range of technology areas)
  - 9 from IP/bar associations (e.g., AIPLA, IPL Section of the ABA, NYIPLA, Boston Patent Law Association, similar associations in Japan)
  - 11 from trade organizations (e.g., IPO, Internet Association, Computer & Communications Industry Association, PhRMA, BIO, similar organizations in Japan)
  - 4 from other organizations
  - 14 from individuals

# Comments on motion to amend practice

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**Request for Comments on Motion to Amend Practice-Deadline extended** [NEW](#)

**Comments on Motion to Amend Practice and Procedures in AIA Trials** [NEW](#)

**Claim Construction Final Rule** [NEW](#)

**SOP 1 (rev. 15): Assignment of judges to panels** [NEW](#)

**SOP 2 (rev. 10): Precedential opinion panel to decide issues of exceptional importance involving policy or procedure** [NEW](#)

## Comments on motion to amend URL:

<https://www.uspto.gov/patents-application-process/patent-trial-and-appeal-board/comments-motion-amend-practice-and>

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# Questions and comments

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